



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/765,762	01/18/2001	Keisuke Shibuya	127747US	8903

7590

07/21/2003

LAW OFFICES  
MARTIN A. FARBER P.C.  
Suite 473  
866 United Nations Plaza  
New York, NY 10017

EXAMINER

HO, HA DINH

ART UNIT

PAPER NUMBER

3681

DATE MAILED: 07/21/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/765,762

Applicant(s)

SHIBUYA, KEISUKE

Examiner

Ha D. Ho

Art Unit

3681

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 21 April 2003 and 19 May 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 2,3 and 6-13 is/are pending in the application.
- 4a) Of the above claim(s) 2, 3 and 6 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 7-13 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413) Paper No(s) \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☒ Other: *Exhibit*.

### DETAILED ACTION

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submissions filed on 4/21/03 and 5/19/03 have been entered.

2. This Office Action is responsive to Applicant's Amendment filed on 4/21/03. Claims 7, 8 and 12 have been amended accordingly. Claims 2, 3 and 6-13 are currently pending.

3. Claims 2, 3 and 6 were withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected species, there being no allowable generic or linking claim. Election was made without traverse on 04/24/02, Paper No. 6.

**4. It is noticed that claims 2, 3 and 6 now depend to the canceled claim 1, which are improper dependent claims.**

#### *Claim Rejections - 35 USC § 112*

5. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

6. Claims 8 and 12 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant

Art Unit: 3681

art that the inventor(s), at the time the application was filed, had possession of the claimed invention. This is so because claims 8 and 12 recite the limitations of “*said counter shaft is offset in a widthwise direction of said main shaft and said front drive shaft is offset in another widthwise direction of said main shaft*” while claim 7 previously recites “*a front drive shaft coaxially connected to said counter shaft*”. The features in combination of claims 7, 8 and 12 are not shown or described.

***Claim Rejections - 35 USC § 102***

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

8. Claims 7-13 are rejected under 35 U.S.C. 102(b) as being anticipated by Kobayashi (EP 0 386 922).

Kobayashi’922 teaches a manual transmission (30) mounted on a vehicle having an engine (10), a crankshaft (11), a clutch (13), a main shaft (14, 16), a counter shaft (19), a gear train (31-39), a front drive shaft (20) coaxially connected to said counter shaft (19), and a front differential (21) provided under said counter shaft (19), comprising

a transmission case (1) for enclosing said main shaft, said counter shaft, said gear train, said front drive shaft and said front differential (see Fig. 1); and

an auxiliary front transmission case (see Exhibit) provided in a front portion of the transmission case (1) being able to receive additional gears for realizing a multiple speed ratio transmission (e.g., that front transmission case is able to receive the sub transmission 15).

Art Unit: 3681

Regarding claims 8 and 12, as best understood, Kobayashi'922 shows the countershaft (19) is offset in a widthwise direction of the main shaft (14, 16) (i.e., from one outer diameter to the other), and said front drive shaft (20) is offset in the other widthwise direction of the main shaft (14, 16) (i.e., from one outer diameter to the other).

Regarding claims 9, 11 and 13, wherein the transmission case (1) includes said auxiliary front transmission case with a front wall (see Exhibit) with bearings, an intermediate transmission case (see Exhibit), a cover attached to a rear transmission case (see Exhibit), and an auxiliary transmission room (see Exhibit) (note that if it is required, this room is able to contain an auxiliary transmission).

Regarding claim 10, Kobayashi'922 shows a front drive gear (51) mounted on the counter shaft (19).

### ***Response to Arguments***

9. Applicant's arguments filed on 4/21/03 have been fully considered but they are not persuasive.

Applicant states that Kobayashi neither discloses nor suggests an auxiliary front transmission case being able to receive additional gears (page 6, 2<sup>nd</sup> paragraph). Examiner disagrees because the auxiliary front transmission case (see Exhibit) of Kobayashi is capable of receiving additional gears, i.e., the sub transmission 15 (see Fig. 1).

Applicant asserts that the front case of Kobayashi is able to receive a front transmission (page 6, 2<sup>nd</sup> paragraph). Note that the front transmission or the sub transmission (15) is interpreted as the additional gears. Further, the "additional gears" are not positively claimed in

Art Unit: 3681

the claim. The recitations of the claim only recite the capability of the "front transmission case" and such capability is shown by Kobayashi.

Applicant further argues that the "the front transmission of the present claimed invention is not required to be contained within the "front transmission case" (page 6, last paragraph to page 1, 1<sup>st</sup> paragraph). It is noted that the features upon which applicant relies are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

As to applicant's argument regarding claims 8 and 12 (page 7, 3<sup>rd</sup> paragraph), please see the paragraph 6 above.

#### ***Communication***

10. Submission of your response by facsimile transmission is encouraged. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9326 for regular communications and (703) 872-9327 for After Final communications. Recognizing the fact that reducing cycle time in the processing and examination of patent applications will effectively increase a patent's term, it is to your benefit to submit responses by facsimile transmission whenever permissible. Such submission will place the response directly in our examining group's hands and will eliminate Post Office processing and delivery time as well as the PTO's mail room processing and delivery time. For a complete list of correspondence not permitted by facsimile transmission, see M.P.E.P. 502.01. In general, most responses and/or amendments not requiring a fee, as well as those requiring a fee but charging such fee to a deposit account, can be submitted by facsimile transmission. Responses requiring a fee which applicant is paying by check should not be submitting by facsimile transmission separately from the check. Responses submitted by facsimile transmission should include a Certificate of Transmission (M.P.E.P. 512). The following is an example of the format the certification might take:

I hereby certify that this correspondence is being facsimile transmitted to  
the Patent and Trademark Office on \_\_\_\_\_

(Date)

Typed or printed name of person signing this certificate:

\_\_\_\_\_  
\_\_\_\_\_

Art Unit: 3681

(Signature)

If your response is submitted by facsimile transmission, you are hereby reminded that the original should be retained as evidence of authenticity (37 CFR 1.4 and M.P.E.P.. 502.02). Please do not separately mail the original or another copy unless required by the Patent and Trademark Office. Submission of the original response or a follow-up copy of the response after your response has been transmitted by facsimile will only cause further unnecessary delays in the processing of your application; duplicate responses where fees are charged to a deposit account may result in those fees being charged twice.

Any inquiry concerning this communication or earlier communication from the examiner should be directed to Examiner Ho whose telephone number is (703) 305-0738. The examiner can normally be reached on Monday-Friday from 7:30 A.M. to 5:00 P.M. Eastern Standard Time. If attempts to reach the examiner by phone are unsuccessful, the examiner's supervisor, Mr. Charles Marmor, can be reached at (703) 308-0830. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-2168.

*Ha Ho 7/18/03*

Ha Ho  
Patent Examiner  
Art Unit 3681